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DEC 19 2008

OFFICE OF PETITIONS

In re Application of :
Newnam, et al. : DECISION ON PETITION
Application No. 09/899,827 :
Filed: July 6, 2001 :
Atty. Dkt. No.: 58849/G476 :

The above-identified application has been forwarded to the Office of Petitions for consideration of the "PETITION REQUESTING RESETTING OF RESPONSE DEADLINE TO JULY 31, 2008, AND WAIVER OF PETITION FEE AND EXTENSION FEES," 37 CFR 1.181 filed July 31, 2008. This matter is also being treated as a petition to withdraw the holding of abandonment.

The petition under 37 CFR 1.181 to withdraw the holding of abandonment is hereby **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is not a final agency decision.

The application became abandoned May 2, 2008 for failure to timely submit a proper reply to the final Office action mailed November 1, 2007. The final Office action set a three month shortened statutory period of time for reply. A reply, including two month extension of time, was filed March 7, 2008. The reply failed the place the application in condition for allowance, as indicated in the Advisory Action mailed July 2, 2008. A petition for extension of time was filed May 1, 2008. This decision precedes Notice of Abandonment.

Petitioners herein argue that the time period for reply should be reset to extend the period of time for reply to the final Office action to July 31, 2008 because the delay in filing the reply submitted herewith (request under 37 CFR 1.114) was not applicants' fault. Petitioners' further state that the examiner reassured the applicant "that the application would not be deemed to be abandoned because the delay of the Advisory Action was not Applicant's fault."

Petitioners' arguments have been carefully considered, but are not convincing. Evidence of non-receipt of an Office communication or action (e.g., Notice of Abandonment or an Advisory Action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See, Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); Krahn v. Commissioner, 15 USPQ2d 1823, 1824 (E.D. Va 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

In accordance with 37 CFR 1.2, “[a]ll business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.”

Applicants’ reliance upon the oral advice of USPTO employees is not cause for withdrawal of the holding of abandonment or resetting the period of time for reply to the final Office action.

Further, proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal. See, 37 CFR 1.116 and 1.135(b).

Applicants did not submit a proper reply to the final Office action (request under 37 CFR 1.114) until after the maximum period of time for reply to the final Office action had expired. Applicants permitted the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action rather than seek appeal or continued examination. The consequence of such delay is abandonment.

Moreover, the period of time for reply to the final Office action cannot be reset or extended as the period of time for reply to the final Office action is statutorily set. See, 35 USC 133. Accordingly, the Office is without the authorization to reset or extend the period of time for reply to the final Office action.

ALTERNATE VENUE

Petitioners may wish to consider filing a petition stating that the delay was unintentional. Petitioner’s attention is directed to 37 CFR 1.137(b) which provides for the revival of an “unintentionally” abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was “unavoidable”. An “unintentional” petition under 37 CFR 1.137(b) must be accompanied by the required petition fee and reply.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail: **Mail Stop Petition**
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Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3205.



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